

REMARKS

In the Final Office Action¹ mailed April 30, 2007, the Examiner rejected claims 1-12, 14-30, 32-48 and 50-54 under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,401,085 to Gershman et al. ("Gershman") in view of U.S. Patent No. 6,061,660 to Eggleston ("Eggleston").

By this Amendment filed concurrently with a Request for Continued Examination, Applicants amend claims 1, 2, 6, 10, 12, 16, 17, 18, 19, 20, 28, 30, 32, 33, 34, 35, 36, 37, 46, 48, and 52, add new claims 54-58, and cancel claims 9, 27, and 45 without prejudice or disclaimer. For the reasons stated below, Applicants respectfully traverse the rejections of claims 1-12, 14-30, 32-48, and 50-54 under 35 U.S.C. § 103(a).

I. THE REJECTION OF CLAIMS 1-12, 14-30, 32-48 AND 50-54 UNDER 35 U.S.C. § 103(A) IS LEGALLY DEFICIENT BECAUSE THE EXAMINER DID NOT ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Here, the Examiner fails to establish a *prima facie* case of obviousness because, among other things, neither *Gershman* nor *Eggleston*, taken alone or in combination, teaches or suggests each and every element of Applicants' claims. For example, claim 1 recites a method for providing solicitations and web-based offers and receiving corresponding responses thereto, including, among other things:

providing a solicitation to a set of users sharing pre-selected characteristics, incorporating in the solicitation at least an offer code and a universal resource locator (URL) corresponding to a web site.

In rejecting claim 1, the Examiner admits that *Gershman* fails to teach "solicitations, url, and offer code" (Final OA at p. 4). However, according to the Examiner, *Eggleston* "discloses solicitations, url, and offer code in relation to incentive programs and award fulfillment." A proper review of this reference, however, demonstrates that this is not correct.

A. GERSHMAN AND EGGLESTON FAIL TO DISCLOSE OR SUGGEST "SOLICITATIONS," AS RECITED IN THE CLAIMS

Gershman discloses a handheld wireless device that is used to scan the UPC bar code of a product for obtaining information on the product via Web sites. (*Gershman* at col. 37, line 57 to col. 38, line 50.) Contrary to the Examiner's suggestion, *Gershman* does not disclose or suggest a set of users sharing pre-selected characteristics, as recited in claim 1. Further, *Eggleston* describes a "typical user" logging on to a website and participating in "one or more incentive programs." The "incentive programs" disclosed by *Eggleston* include "scratch-and-win games, sweepstakes, games, treasure hunt games or computer games" (col. 13, lines 43-47). Therefore, while *Eggleston* may include "incentive programs"

accessible by a consumer by logging on to a website, this does not constitute “providing solicitations,” as recited in claim 1 because the claimed “solicitation” incorporates “an offer code.” Furthermore, according to *Eggleston* at col. 13, lines 43-47, a “typical consumer may log on to the web site, register as with the host system, and participate in one or more incentive programs.” Thus, rather than “providing a solicitation to a set of users sharing pre-selected characteristics,” as recited in claim 1, *Eggleston* discloses a “typical consumer” which “logs on” and “participates” in one or more incentive programs.

B. GERSHMAN AND EGGLESTON FAIL TO DISCLOSE OR SUGGEST AN “OFFER CODE” AS RECITED IN THE CLAIMS

The Examiner alleges that *Eggleston* discloses an offer code as recited in claim 1 at col. 1, line 63 to col. 2, line 8, which “discloses the code for the inventive program” (Final OA at p. 2). Yet, *Eggleston* merely discloses that a “problem exists for sponsoring companies who wish to offer promotions” (col. 1, lines 63-64). Therefore, “offer,” as employed by *Eggleston* in the cited passages, is presented as a verb, rather than a noun. Nothing in *Eggleston* discloses or suggests a “solicitation” incorporating “an offer code,” as recited in claim 1. While the Examiner now relies on Figs. 10-17 of Eggleston (Final OA at p. 2), Applicants fail to recognize which portions of these figures correspond to an “offer code,” as recited in Applicants’ claims.

C. GERSHMAN AND EGGLESTON FAIL TO TEACH OR SUGGEST HISTORY INFORMATION AND MODIFYING AN OFFER

Further, the cited art does not teach or suggest collecting information reflecting an access history of the at least one user in relation to the offer and modifying the offer based on the collected information, as recited in amended

claim 1. While *Gershman* stores meeting records (e.g., col. 11, lines 49-62), such features do not disclose or suggest collecting information and modifying an offer, as recited in amended claim 1. Nor does *Eggleston* make up for the deficiencies of *Gershman*. Accordingly, for these additional reasons claim 1 should be allowed.

D. THE REJECTION OF CLAIMS 1-12, 14-30, 32-48, AND 50-54 IS LEGALLY DEFICIENT BECAUSE THE EXAMINER'S ASSERTED REASONING FOR COMBINING *GERSHMAN* AND *EGGLESTON* FAIL TO ADDRESS THE EXAMINER'S POSITION FOR COMBINING THE REFERENCES

The Examiner asserts it would have been obvious to “include solicitations, url, and offer code in relation to incentive programs in an internet system to promote products as disclose[d] in *Eggleston*.” (Final OA at 3.) However, this reasoning, even if accepted by Applicants—which it is not—fails to properly support combining the cited art to make up for the admitted deficiencies of *Gershman*. For instance, the Examiner relies on *Eggleston* to allegedly disclose solicitations, a URL, and an offer code. *Id.* Yet, in presenting the reason for the alleged combination of the cited art, the Examiner does not “identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed,” i.e., a solicitation that incorporates an offer code and a URL. Indeed, the Examiner asserts *Eggleston* discloses “solicitations” via advertisements or product logos as part of an object viewed by a consumer when playing an incentive program. *Id.* Yet this reasoning would mean the advertisements or product logos when combined with *Gershman* must include the offer code and URL as recited in Applicants’ claims. Nowhere does the Examiner offer any reasoning how one of ordinary skill in the art

at the time of Applicants' invention would have been motivated to combine the cited art to suggest Applicants' claims.

E. *GERSHMAN AND EGGLESTON FAIL TO TEACH OR SUGGEST THE RECITATIONS OF INDEPENDENT CLAIMS 12, 16, 19, 30, 34, 37, 48, AND 52*

Claims 12, 16, 19, 30, 34, 37, 48, and 52, although of different scope, include recitations similar to those of claim 1. Accordingly, the cited art also cannot render obvious independent claims 12, 16, 19, 30, 34, 37, 48 and 52 for at least the same reasons set forth above in connection with claim 1. Therefore, the rejection of these claims under 35 U.S.C. § 103(a) is legally deficient and should be withdrawn.

F. *GERSHMAN AND EGGLESTON FAIL TO TEACH OR SUGGEST THE RECITATIONS OF DEPENDENT CLAIMS 2-11, 14, 15, 17, 18, 20-29, 32, 33, 35, 36, 38-47, 50, 51, 53, AND 54*

Claims 2-11, 14, 15, 17, 18, 20-29, 32, 33, 35, 36, 38-47, 50, 51, 53, and new claims 54-58 depend respectively from independent claims 1, 12, 16, 19, 30, 34, 37, 48, and 52. As explained, neither *Gershman* nor *Eggleson* support the rejection of claims 1, 12, 16, 19, 30, 34, 37, 48, and 52. Accordingly, the cited art also fails to support the rejection of dependent claims 2-11, 14, 15, 17, 18, 20-29, 32, 33, 35, 36, 38-47, 50, 51, and 53-58 under 35 U.S.C. § 103(a) for at least the same reasons set forth above in connection with claim 1. Therefore, the rejection of these claims under 35 U.S.C. § 103(a) is legally deficient and should be withdrawn.

Further, the Examiner's basis for rejecting these claims is also legally deficient. For example, in rejecting claims 2, 20, and 38, the Examiner contradicts the position taken in connection with independent claims 1, 12, and 37. The Examiner asserts that *Gershman* does not teach solicitations. (Final OA at 3.) Yet, in rejecting claims 2, 20, and 38, the Examiner asserts *Gershman* discloses an offer

code “incorporated in the solicitation” is entered by the user at the web site. *Id.* Notwithstanding the fact that Figs. 1a, 9, and 25 of *Gershman* offer no disclosure of providing a solicitation that includes an offer code, the Examiner provides no reason for modifying the reference to disclose such features. Indeed, the Examiner does not rely on *Eggleston* or any other prior art in the rejection, offer no suggestion to modify *Gershman* in a manner that suggests the recitations of claims 2, 20, and 38, and provides not motivation for doing so. Accordingly, the rejection of these claims fails on two fronts. First, if the Examiner is relying solely on *Gershman* to teach the recitations of these claims, the argument contradicts the position taken in rejecting corresponding independent claims 1, 12, and 37. Moreover, *Gershman* fails to actually disclose such features. Second, if the Examiner is relying on obviousness to reject claims 2, 20, and 38, the rejection is deficient because it fails to provide prior art that teaches a solicitation incorporating an offer code, and fails to provide a suggestion and motivation for modifying *Gershman*. Similar deficiencies are found in the rejection of claims 3, 21, 39; claims 5, 23, 41; claims 6, 8, 24, 42; claims 10, 28, 46; and claims 15, 18, 33, 36, 51, and 53.

II. CONCLUSION

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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